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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,101	07/08/2003	Ying Luo	RIGL-010CIP3	5361

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EXAMINER

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
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1652

MAIL DATE	DELIVERY MODE
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04/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/616,101</p>	<p>Applicant(s) LUO ET AL.</p>	
	<p>Examiner Manjunath N. Rao, Ph.D.</p>	<p>Art Unit 1652</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 05 April 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 38-43.
Claim(s) withdrawn from consideration: 45-47.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Manjunath N. Rao, Ph.D.
Primary Examiner
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Advisory Action

Claims 38-43, 45-47 are now currently pending in this application. Claims 38-43 are now under consideration. Claims 45-47 remain withdrawn from consideration as being drawn to non-elected invention.

Applicant's request for reconsideration filed on 4-5-07 has been considered and ENTERED. However, claims are still not in condition for allowance for the following reasons. Examiner continues to maintain the rejection of claims 38-40 and 42 as being anticipated by Daly et al. In response to the above rejection in the previous Office action, applicant maintains the argument that Daly fails to disclose a composition containing a source of ADP-ribose and, as such, fails to disclose the subject matter of the rejected claims and that Daly cannot anticipate the rejected claims. Applicants also recite from the MPEP regarding rejection of claims based on inherency. Applicants maintain that in order for the rejection to be correctly established, a claim limitation that is not explicitly taught must be inherent, i.e., necessarily present, in the cited prior art and that the mere possibility that the limitation is taught in the art is not sufficient to merit such a rejection, and the mere fact that a certain thing may result from a given set of circumstances is also not sufficient. While that may be so, Examiner has not based his inherency argument on unscientific grounds or as a mere possibility. In the instant case, applicants are claiming a polypeptide that is 95% identical to SEQ ID NO:3 as having PARP activity. Examiner has shown a sequence in the prior art that has an amino acid sequence that is greater than that (97% sequence identity) claimed by the applicant and it is based on such scientific reasoning that Examiner has concluded that the reference polypeptide inherently comprises the PARP activity. However, applicants provide no such scientific evidence to show

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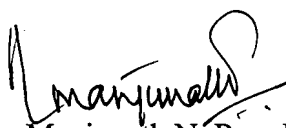
that the reference polypeptide inherently does not have said property. Examiner will be willing to withdraw the rejection if applicants can experimentally show that the reference polypeptide does not have PARP activity or file an affidavit or a Declaration declaring that the reference polypeptide does not inherently have said activity. Until such time, Examiner continues to maintain the above rejection.

For the very same above reasons, Examiner continues to maintain the rejection of claims 41, 43-44 as being obvious under 35 USC 103(a), over Daly et al., and Smith et al.

Conclusion

None of the claims are allowable.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



Manjunath N. Rao, Ph.D.
Primary Examiner
Art Unit 1652

April 25, 2007